

*second*  
H first state wherein the active engagement member does not engage the compatible *first*  
member to a second state wherein the active *second* engagement member engages the compatible *first*  
engagement member to prevent safety release of the second engagement member from the first  
engagement member during riding; and

wherein the second engagement member is adapted to automatically disengage from the first engagement member in response to the snowboard boot stepping out of engagement with the binding.

*80*  
*74.* (Four Times Amended) A method of interfacing a first engagement member mounted to a snowboard boot with a second engagement member, on a non-safety-releasable snowboard binding, that is engageable with the first engagement member to mount the snowboard boot to the snowboard binding and prevent safety release of the snowboard boot from the snowboard binding during riding, wherein at least one of the first and second engagement members is an active engagement member that is moveable, relative to the one of the snowboard boot or the snowboard binding on which the active engagement member is located, between an open position and a closed position, the method comprising a step of:

- (A) stepping the snowboard boot out of the snowboard binding so that the active engagement member automatically moves from the closed position to the open position without operating a lever on the snowboard boot or the snowboard binding, so that the first engagement member is disengaged from the second engagement member.

#### REMARKS

In response to the Office Action dated September 10, 2002, Applicants respectfully request reconsideration.

Initially, the undersigned wishes to thank Examiner Vanaman for the courtesies extended in granting and conducting a telephone interview on October 9, 2002. The substance of the telephone interview is summarized below.

Claims 1-28, 30-43 and 45-86 are pending, with claims 78 and 82-86 being withdrawn from consideration. Claims 24, 33-43, 45-50, 73, 80, and 81 are allowed. Claims 6, 13-14, 16, 20-23, 26, 28, and 65 have been indicated as allowable if rewritten to overcome the rejections under 35 U.S.C. §112, second paragraph and to include all of the limitations of their base claims and any intervening claims.

#### Election/Restriction

Claims 78 and 82-86 stand withdrawn from further consideration as being drawn to a nonelected species. Applicants have not cancelled these claims since their base claims and any intervening claims are allowable generic or linking claims. Accordingly, Applicants respectfully request allowance of claims 78 and 82-86.

#### Miscellaneous Papers

The Office Action notes that a substitute specification, copies of the drawings and non-marked claims, unaccompanied by a transmission letter or explanation of relevance, have been placed in the file but not entered in the application. Applicants believe that these papers were matched with the present application in error by PTO personnel, as these papers were apparently separated from an Information Disclosure Statement filed in connection with one or more of Serial Nos. 09/990,581; 10/151,191; or 10/151,194 citing the present application as a relevant co-pending application.

#### Rejections under 35 U.S.C. § 112, Second Paragraph

In Paragraph 6 of the Office Action, claims 1-23, 25-28, 30-32, 51-72, 74-77 and 79 are rejected under 35 U.S.C. § 112, paragraph 2 as purportedly being indefinite. Specifically, the Office Action asserts that the language in the claims reciting a binding as being non-safety releasable appears to be contradictory with the language reciting an engagement member capable of an automatic release. As discussed during the telephone interview, these recitations (one to the binding as a whole and the other to a particular engagement member) are not contradictory, such that the claims are definite and the rejection under §112, ¶2 should be withdrawn.

Claim 1

Independent claim 1 recites, *inter alia*, a non-safety-releasable snowboard binding and an automatically movable active engagement member. As discussed during the telephone interview, the term “non-safety-releasable” applies to the binding as a whole, whereas the term “automatic” is applied to an engagement member of the binding. As noted in Applicants’ response filed February 11, 2002, a non-safety-releasable binding prevents inadvertent release of the boot from the binding during riding, even when a rider falls. The automatic feature, on the other hand, applies to an active engagement member that moves to a disengaged state in response to the rider stepping out of the binding. These terms are not inconsistent, since a binding may include an automatic engagement member and still be a non-safety-releasable binding.

Applicants’ specification describes illustrative embodiments which demonstrate that these terms are not inconsistent. For example, as discussed during the interview, Fig. 15 illustrates a non-safety releasable binding having an engagement member 407 at the toe end that is automatically releasable in response to the rider lifting the heel first and pivoting (about the ball of the foot) forward out of the binding. Despite this automatically releasable feature at the toe end, the binding is not safety releasable, because it includes a heel retention system that does not release during riding and that prevents the heel from pivoting forward in the manner necessary to automatically release the toe.

Although no agreement was reached during the interview, the Examiner appreciated Applicants’ explanation, and agreed to reconsider the rejection.

In view of the foregoing, independent claim 1 particularly points out and distinctly claims subject matter which Applicants regard as the invention. Therefore, it is respectfully asserted that the rejection of claim 1 (as well as dependent claims 2-23, 25-28, 30-32, and 79) under 35 U.S.C. § 112, paragraph 2 should be withdrawn.

Claim 51

Independent claim 51, as amended, recites a snowboard boot for use with a non-safety-releasable binding to mount the snowboard boot to a snowboard. The boot includes a second

engagement member adapted to automatically disengage from a first engagement member on the binding. As noted above with respect to claim 1, the term “non-safety-releasable” refers to the binding as a whole, whereas the term “automatic” refers to the interaction between the first and second engagement members. For the reasons stated above, the terms “non-safety-releasable” and “automatic” are not inconsistent, and do not render claim 51 indefinite. Therefore, it is respectfully requested that the rejection of claim 51 (as well as claims 52-53 that depend therefrom) under 35 U.S.C. § 112, paragraph 2 be withdrawn.

#### Claim 54

Independent claim 54 recites a non-safety-releasable snowboard binding to mount a snowboard boot to a snowboard, including an active engagement member which is automatically moveable from an engaged state to a disengaged state. As with claim 1, the term “non-safety-releasable” is applied to the binding as a whole, whereas the term “automatically” is applied to an engagement member of the binding. Accordingly, these terms are not inconsistent and do not render claim 54 indefinite. Therefore, it is respectfully requested that the rejection of claim 54 (as well as claims 55-72 that depend therefrom) under 35 U.S.C. § 112, paragraph 2 be withdrawn.

#### Claim 74

Independent claim 74, as amended, recites a method of interfacing a first engagement member mounted to a snowboard boot with a second engagement member on a non-safety-releasable snowboard binding. The method comprises a step of stepping the snowboard boot out of the snowboard binding so that the active engagement member automatically moves from a closed position to an open position. As with claim 1, the terms “non-safety-releasable” and “automatically” are not used inconsistently since a non-safety-releasable binding may include an automatic engagement member. In view of the foregoing, it is believed that independent claim 74 particularly points out and distinctly claims subject matter which Applicants regard as the invention. Therefore, it is respectfully requested that the rejection of claim 74 (and claims 75-78 that depend therefrom) under 35 U.S.C. § 112, paragraph 2 be withdrawn.

Claim 61

The Office Action included independent claim 61 in the list of claims rejected under §112, ¶2 as having purportedly inconsistent language regarding non-safety-releasable and automatic release. As discussed during the interview, Applicants' attorneys noted that the amendment of May 16, 2001 inadvertently amended dependent claim 61 to be identical to amended claim 54, and sought to correct claim 61 in the amendment filed February 11, 2002 (see paragraph 2, page 5). Applicants later discovered another error in the marked up claims section of the February 11, 2002 amendment, and submitted a corrected version of the marked up claims in a Supplemental Response on February 14, 2002. Thus, as it currently stands, claim 61 does not include the purportedly confusing language, so that the rejection of claim 61 under §112, ¶2 should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

In Paragraphs 7-8 of the Office Action, claims 1-5, 7-12, 15, 17-19, 25, 27, 30-32, 51-64, 66-72, 74-77 and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Romano in view of Bobrowicz. This rejection is respectfully traversed.

The Combination is Improper

As discussed during the interview (and in the response filed February 11, 2002, incorporated herein by reference), the Romano bike shoe engagement system is not suitable for use as a snowboard binding, and thus, is not combinable with the snowboard boot and binding system disclosed in Bobrowicz. More particularly, Romano teaches a binding system in which the bike shoe is released from the engaging loops on the pedal in response to a pivoting motion, i.e., rotating the foot of the cyclist in the plane of the pedal. The release of the boot from the binding in response to such a force (which is common in snowboarding) renders the Romano binding system unsuitable for use in a snowboard binding.

A typical snowboard binding is mounted in a direction generally across the edges of the board. So, unlike in skiing where the ski binding is mounted in a tip to tail direction, a snowboard rider's toes point toward one edge of the board ("toe side edge") while her heels are positioned relative to the other edge of the board ("heel side edge"). The rider applies



forces through the boot and binding to tip the snowboard on either the toe side edge or the heel side edge to steer the board when carving a turn. For example, in a toe side turn, the rider flexes her knees and rotates the snowboard toward the toe edge. Lateral forces on the sides of the boot are also applied and experienced due to gravity (e.g., the board is tipped on edge forcing the heel higher than the toe) and due to tangential and centrifugal forces during turns.

In view of the forces on a boot and binding, if the Romano binding were used in a snowboard binding, the binding would inadvertently or involuntarily release the boot during riding. Such inadvertent release is undesirable and unsuitable for a snowboard binding, as there is a serious risk of injury to a snowboard rider if one foot is released during riding. Specifically, if one foot is released and the other remains attached to the board, the snowboard (which is heavier than a ski) would create a serious risk of injury to the leg that is still attached to the board. As a result, virtually all commercially available snowboard bindings are not safety releasable.

Since the forces to disengage the boot from the binding in the Romano system are of the type experienced during riding of a snowboard, one of ordinary skill in the art would not have been motivated to employ the binding of Romano in the snowboard boot/binding system disclosed in Bobrowicz. Thus, it is respectfully asserted that the purported combination of Romano and Bobrowicz is improper, and that the rejection of the claims under §103 as being obvious over this combination should be withdrawn.

While no formal agreement was reached during the telephone interview, the Examiner indicated that he would reconsider the rejection in view of Applicants' arguments.

#### The Claims Distinguish Over Any Combination

Even if one skilled in the art were motivated to employ the Romano binding system in the snowboard boot/binding system of Bobrowicz, the pivoting movement of Romano within the plane of the pedal to disengage the boot would result in a safety-releasable binding. As such, the combination would fail to teach a non-safety releasable binding (claims 1 and 54), a boot for use with a non-safety-releasable binding (claim 51), or a method of interfacing a boot with a non-safety-releasable binding (claim 74). Thus, Applicants respectfully submit that all of Applicants'

claims are patentable over Romano in view of Bobrowicz, and that the rejection of these claims should be withdrawn.

The Office Action suggests that Applicants have, at different times, argued different "definitions" of what is meant by a non-safety releasable binding. Specifically, the Office Action asserts that Applicants had previously pointed to portions of the specification to support a definition as one "wherein no amount of lifting force generated on the toe end of the boot will result in disengagement," and asserts that such an interpretation is met by Romano, in which an upward force will not result in a release.

As discussed during the telephone interview, the references in Applicants' prior responses to portions in the specification which explain that the embodiment of the automatically releasable engagement system shown in the figures is one in which lifting forces do not result in disengagement was not intended to "define" what is meant by a non-safety releasable binding. Rather, this explanation was merely provided to demonstrate that there is support in the specification for a binding that includes an automatic feature but will not release during riding. A non-safety-releasable binding is a term that will be well understood by those of skill in the art to refer to a binding that will not release during riding. Applicants respectfully assert that they have not argued a contrary meaning.

### CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
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MARKED UP CLAIMS

Please amend the claims as follows:

51. (Five Times Amended) A snowboard boot adapted for use with a non-safety-releasable binding to mount the snowboard boot to a snowboard, the binding including a first engagement member, the snowboard boot comprising:

a sole; and

a second engagement member mounted to the sole to engage the first engagement member;

wherein the second engagement member is an active engagement member and the first engagement member is a compatible engagement member that is engageable with the active engagement member, the active engagement member being movable, relative to the sole, from a first state wherein the active engagement member does not engage the compatible engagement member to a second state wherein the active engagement member engages the compatible engagement member to prevent safety release of the second engagement member from the first engagement member during riding; and

wherein the second engagement member is adapted to automatically disengage from the first engagement member in response to the snowboard boot stepping out of engagement with the binding.

74. (Four Times Amended) A method of interfacing a first engagement member mounted to a snowboard boot with a second engagement member, on a non-safety-releasable snowboard binding, that is engageable with the first engagement member to mount the snowboard boot to the snowboard binding and prevent safety release of the snowboard boot from the snowboard binding during riding, wherein at least one of the first and second engagement members is an active engagement member that is moveable, relative to the one of the snowboard boot or the snowboard binding on which the active engagement member is located, between an open position and a closed position, the method comprising a step of:

- (B) stepping the snowboard boot out of the snowboard binding so that the active engagement member automatically moves from the closed position to the open position without operating a lever on the snowboard boot or the snowboard binding, so that the first engagement member is disengaged from the second engagement member.